

Appeal Brief
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REAL PARTY IN INTEREST

The real party in interest in the present Application is International Business Machines Corporation, the Assignee of the present application as evidenced by the Assignment set forth at reel 010773, frame 0646 et. seq. of the USPTO assignment records.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, the Appellants' legal representative, or assignee, which directly affect or would be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 45-49, 51-55, and 57-59 stand finally rejected by the Examiner, as noted in the final Office Action dated January 25, 2007. The rejection of Claims 45-49, 51-55, and 57-59 is appealed.

STATUS OF AMENDMENTS

Appellants' Amendment B filed on November 30, 2005 was entered by the Examiner as indicated in the final Office Action. Amendments to the claims were proposed in Appellants' Amendment C filed on March 12, 2007 but were refused entry by the Examiner in the Advisory Action dated March 21, 2007. No amendments to the claims have been entered subsequent to the Amendment B filed on November 30, 2005.

SUMMARY OF THE CLAIMED SUBJECT MATTER

Appellants' invention may be implemented as a method, apparatus, or a computer program product for electronically registering a user with server systems associated with consumer providers such as retailers. As explained in Appellants' specification on page 5, lines 8-21 and page 6, lines 11-15, the proposed invention enables utilization of a portable computer to manage exchange and processing of consumer preferences to potentially multiple, diverse retailer systems.

Specifically, Appellants' claim 45 recites a method for "automatically electronically registering a user" (see specification page 15, lines 8-15, describing with reference to **FIG. 2**, use of a portable computer system **10** to transmit user preferences to retail servers **80a-80n** which compare the preferences with products and services offered by corresponding retailers). The method comprises "generating a request to transmit a plurality of profile elements to a selected server system from among a plurality of server systems" and "transmitting said request to a portable computer system in response to a determination that said portable computer system is within a particular proximity to said plurality of server systems" (see specification page 32, lines 14-27, describing with reference to **FIG. 3**, a user profile **60** stored within portable computer **10** including elements such as name, sex, account information, etc.; page 35 lines 20-22, describing with reference to **FIG. 3**, portable computer system **10** receiving a registration request from server system **80**; page 41, lines 4-21, describing with reference to **FIG. 4**, a retailer server system control method including steps **108**, **110**, **114**, and **116** in which a generated registration request is sent to a portable computer system; page 43, lines 26-29, describing with reference to **FIG. 5**, a portable computer control method including a step **156** of determining whether a transmit request is received by a portable computer; page 43, lines 21-25 and page 44, lines 3-36, describing with reference to **FIG. 5**, a portable computer control method including steps **156** and **160** in which user profile data is transmitted to a selected server system provided the server system is within a proximate distance from the portable computer.

Following the steps of generating and transmitting, claim 45 recites "receiving a user profile comprising said plurality of profile elements in a particular transmittable data format at said selected server system from said portable computer system," (see page 40, lines 24-27, describing with reference to **FIG. 4**, a retailer server system control method including a step 102 of determining whether profile information was received from a portable computer system; page 41, lines 4-21, describing with reference to **FIG. 4**, a retailer server system control method including steps **108**, **110**, **114**, and **116** in which a generated registration request is sent to a portable computer system; page 22, lines 17-20, describing XML as transmittable data format; page 43, lines 21-25 and page 44, lines 3-36, describing with reference to **FIG. 5**, a portable computer control method including steps **156** and **160** in which user profile data is transmitted to a selected server system provided the server system is within a proximate distance from the portable computer. Further modifying the step of "receiving a user profile," claim 45 recites

“wherein said selected server system is identified at said portable computer system utilizing data within said plurality of profile elements specifying a consumer preference in response to a receipt of said request at said portable computer system, said user profile is associated with a particular user of said portable computer system,” (see specification page 321, line 30 through page 32, line 16, describing with reference to **FIG. 3**, consumer preferences associated with a client which indicate provider preferences such as decorator preferences; page 35 lines 20-24, describing with reference to **FIG. 3**, explaining preference coordination in which consumer preferences are used to select retailer system to register with). The step of “receiving a user profile” is further modified by “each of said plurality of server systems is respectively associated with one of a plurality of consumer providers” (see page 15, lines 9-11, with reference to **FIG. 2**, referring to “retailer” server systems; page 50, original claim 1, lines 7-8).

Claim 45 further recites “registering said particular user with a consumer provider of said plurality of consume providers in response to a receipt of said user profile at said selected server system, wherein said consumer provider is associated with said selected server system” (see page 24, line 20 through page 25, line 12, describing with reference to **FIG. 3**, server system **80** filling an electronic registration for a user having a specified profile and various aspects of registration processing; page 38, lines 1-6, describing with reference to **FIG. 3**, an exemplary user registration of a user in association with a ski resort provider).

Appellants’ claim 51 recites a system for “automatically electronically registering a user” (see specification page 15, lines 8-15, describing with reference to **FIG. 2**, use of a portable computer system **10** to transmit user preferences to retail servers **80a-80n** which compare the preferences with products and services offered by corresponding retailers). The system comprises “means for generating a request to transmit a plurality of profile elements to a selected server system from among a plurality of server systems” and “means for transmitting said request to a portable computer system in response to a determination that said portable computer system is within a particular proximity to said plurality of server systems” (see specification page 32, lines 14-27, describing with reference to **FIG. 3**, a user profile **60** stored within portable computer **10** including elements such as name, sex, account information, etc.; page 35 lines 20-22, describing with reference to **FIG. 3**, portable computer system **10** receiving a registration request from server system **80**; page 41, lines 4-21, describing with reference to **FIG. 4**, a retailer server system control method including steps **108**, **110**, **114**, and **116** in which a generated

registration request is sent to a portable computer system; page 43, lines 26-29, describing with reference to **FIG. 5**, a portable computer control method including a step **156** of determining whether a transmit request is received by a portable computer; page 43, lines 21-25 and page 44, lines 3-36, describing with reference to **FIG. 5**, a portable computer control method including steps **156** and **160** in which user profile data is transmitted to a selected server system provided the server system is within a proximate distance from the portable computer.

Claim 51 further recites “means for receiving a user profile comprising said plurality of profile elements in a particular transmittable data format at said selected server system from said portable computer system,” (see page 40, lines 24-27, describing with reference to **FIG. 4**, a retailer server system control method including a step 102 of determining whether profile information was received from a portable computer system; page 41, lines 4-21, describing with reference to **FIG. 4**, a retailer server system control method including steps **108**, **110**, **114**, and **116** in which a generated registration request is sent to a portable computer system; page 22, lines 17-20, describing XML as transmittable data format; page 43, lines 21-25 and page 44, lines 3-36, describing with reference to **FIG. 5**, a portable computer control method including steps **156** and **160** in which user profile data is transmitted to a selected server system provided the server system is within a proximate distance from the portable computer. Further modifying the means for “receiving a user profile,” claim 51 recites “wherein said selected server system is identified at said portable computer system utilizing data within said plurality of profile elements specifying a consumer preference in response to a receipt of said request at said portable computer system, said user profile is associated with a particular user of said portable computer system,” (see specification page 321, line 30 through page 32, line 16, describing with reference to **FIG. 3**, consumer preferences associated with a client which indicate provider preferences such as decorator preferences; page 35 lines 20-24, describing with reference to **FIG. 3**, explaining preference coordination in which consumer preferences are used to select retailer system to register with). The means for “receiving a user profile” is further modified by “each of said plurality of server systems is respectively associated with one of a plurality of consumer providers” (see page 15, lines 9-11, with reference to **FIG. 2**, referring to “retailer” server systems; page 50, original claim 1, lines 7-8).

Claim 51 further recites “means for registering said particular user with a consumer provider of said plurality of consumer providers in response to a receipt of said user profile at said

selected server system, wherein said consumer provider is associated with said selected server system” (see page 24, line 20 through page 25, line 12, describing with reference to **FIG. 3**, server system **80** filling an electronic registration for a user having a specified profile and various aspects of registration processing; page 38, lines 1-6, describing with reference to **FIG. 3**, an exemplary user registration of a user in association with a ski resort provider).

Appellants’ claim 57 recites a computer program product residing on a computer usable medium and having computer readable program code means encoded therein for “automatically electronically registering a user” (see specification page 15, lines 8-15, describing with reference to **FIG. 2**, use of a portable computer system **10** to transmit user preferences to retail servers **80a-80n** which compare the preferences with products and services offered by corresponding retailers). The program product comprises “program code means for generating a request to transmit a plurality of profile elements to a selected server system from among a plurality of server systems” and “program code means for transmitting said request to a portable computer system in response to a determination that said portable computer system is within a particular proximity to said plurality of server systems” (see specification page 32, lines 14-27, describing with reference to **FIG. 3**, a user profile **60** stored within portable computer **10** including elements such as name, sex, account information, etc.; page 35 lines 20-22, describing with reference to **FIG. 3**, portable computer system **10** receiving a registration request from server system **80**; page 41, lines 4-21, describing with reference to **FIG. 4**, a retailer server system control method including steps **108**, **110**, **114**, and **116** in which a generated registration request is sent to a portable computer system; page 43, lines 26-29, describing with reference to **FIG. 5**, a portable computer control method including a step **156** of determining whether a transmit request is received by a portable computer; page 43, lines 21-25 and page 44, lines 3-36, describing with reference to **FIG. 5**, a portable computer control method including steps **156** and **160** in which user profile data is transmitted to a selected server system provided the server system is within a proximate distance from the portable computer.

Claim 57 further recites “program code means for receiving a user profile comprising said plurality of profile elements in a particular transmittable data format at said selected server system from said portable computer system,” (see page 40, lines 24-27, describing with reference to **FIG. 4**, a retailer server system control method including a step **102** of determining whether profile information was received from a portable computer system; page 41, lines 4-21,

describing with reference to **FIG. 4**, a retailer server system control method including steps **108**, **110**, **114**, and **116** in which a generated registration request is sent to a portable computer system; page 22, lines 17-20, describing XML as transmittable data format; page 43, lines 21-25 and page 44, lines 3-36, describing with reference to **FIG. 5**, a portable computer control method including steps **156** and **160** in which user profile data is transmitted to a selected server system provided the server system is within a proximate distance from the portable computer. Further modifying the program code means for “receiving a user profile,” claim 57 recites “wherein said selected server system is identified at said portable computer system utilizing data within said plurality of profile elements specifying a consumer preference in response to a receipt of said request at said portable computer system, said user profile is associated with a particular user of said portable computer system,” (see specification page 321, line 30 through page 32, line 16, describing with reference to **FIG. 3**, consumer preferences associated with a client which indicate provider preferences such as decorator preferences; page 35 lines 20-24, describing with reference to **FIG. 3**, explaining preference coordination in which consumer preferences are used to select retailer system to register with). The program code means for “receiving a user profile” is further modified by “each of said plurality of server systems is respectively associated with one of a plurality of consumer providers” (see page 15, lines 9-11, with reference to **FIG. 2**, referring to “retailer” server systems; page 50, original claim 1, lines 7-8).

Claim 57 further recites “program code means for registering said particular user with a consumer provider of said plurality of consume providers in response to a receipt of said user profile at said selected server system, wherein said consumer provider is associated with said selected server system” (see page 24, line 20 through page 25, line 12, describing with reference to **FIG. 3**, server system **80** filling an electronic registration for a user having a specified profile and various aspects of registration processing; page 38, lines 1-6, describing with reference to **FIG. 3**, an exemplary user registration of a user in association with a ski resort provider).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The rejection of claims 45-49, 51-55, and 57-59 under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 6,823,327 issued to Klug et al., (hereinafter, *Klug*) in view of United States Patent No. 6,055,573 issued to Gardenswartz, (hereinafter, *Gardenswartz*) and in further view of United States Patent App. No. 2002/0023123 filed by Madison et al., (hereinafter, *Madison*) is to be reviewed on Appeal.

ARGUMENT

A. The rejection of claims 45, 51, and 57 under 35 U.S.C. §103(a) as being unpatentable over *Klug* in view of *Gardenswartz* and in further view of *Madison* is not well founded and should be reversed.

The prior art as a whole fails to disclose each claimed feature and the combinations of features recited in claims 45, 51, and 57

The grounds for rejecting claims 45, 51, and 57 fail to address whether the cited or otherwise known prior art taken as a whole discloses the *combination* of claim elements. This basic flaw is facially obvious from even a cursory review of the grounds of rejection in which the treatment of claim elements for claims 45, 51, and 57 is presented in a conspicuously disjointed and out-of-order manner which renders a focused analysis of whether the prior art as a whole teaches the claimed combination of elements virtually impossible. The final Office Action addresses individual elements (i.e., portions of claim body separated by semicolons) in complete isolation and ignores inventive features that reside in expressly recited relationships between and among the claim elements.

Regarding independent claim 45, representative also of independent claims 51 and 57, the final Office Action fails to address aspects of the “request” recited in the first two claim elements. Namely, claim 45 includes a request generation step reciting “generating a request to transmit a plurality of profile elements to a selected server system from among a plurality of server systems.” A further aspect of the “request” is recited as “transmitting said request to a portable computer system in response to a determination that said portable computer system is within a particular proximity to said plurality of server systems.” Claim 45 therefore expressly requires that the request transmitted to a portable computer system in response to a determination

that the portable computer system is within a particular proximity to a plurality of servers must also be a request to transmit a plurality of profile elements to a selected server system from among a plurality of server systems.

The prior art including the combination of *Klug*, *Gardenswartz*, and *Madison* fails to disclose the foregoing combined features relating to the claimed “request.” On page 4, the final Office Action asserts that “transmitting said request to a portable computer system in response to a determination that said portable computer system is within a particular proximity to said plurality of server systems” is rendered obvious by the combination of the prior art. Following this unsupported assertion, the Office Action asserts *Klug* discloses “generating a request to transmit a plurality of profile elements to a selected server system from among a plurality of server systems” at FIG. 1. Appellants note that FIG. 1 of *Klug* is a block diagram of a web site registration information processing system depicted as generally functioning within a networked environment. *Klug*’s FIG. 1 depicts various World Wide Web (WWW) entities including a client node 108 having a resident browser 120 and interconnected via WWW 104 to a registrar website 100 and third party websites 116. Nothing in FIG. 1 itself or its description beginning at col. 4, line 20, discloses or suggests a step in which registrar website 120 or any other equivalent requestor generates a request to transmit multiple profile elements that is transmitted in response to a portable computer being within a specified proximity to multiple servers as expressly required by the claim language.

In regard specifically to the “transmitting” step in claim 45, page 9 of Office Action asserts that *Madison* discloses communicating with a portable computer system in response to a determination that said portable computer system is within a particular proximity to said plurality of server systems/website/particular locations (Abstract; Fig. 2; Fig. 3; para. [7, 32]) and that based on the position of the user a request for demographic information will or will not be made ([32]). *Madison*’s disclosure relates to using client node geographic location to determine the content of data to send to or block from the client (see Abstract; FIG. 3, steps 308 and 312; paragraph [0032], describing determination of client’s geographic location at step 308 and resultant use of the determined location data by Web server to send targeted, location-specific data to the client). While *Madison* does disclose a geographic cookie file that may be used to transmit localized data or to block transmission of data to specified geographic location (step 310, paragraph [0032]), nothing in *Madison* or the other references in any combination discloses

“transmitting said request to a portable computer system in response to a determination that said portable computer system is within a particular proximity to said plurality of server systems” (i.e., using proximity of a portable computer system to a plurality of server systems as a determining factor in whether to transmit a request to transmit a plurality of profile elements).

Similar to *Madison*, *Gardenswartz* discloses a system/method for providing location – specific data (e.g., targeted advertising) and fails to disclose “transmitting said request to a portable computer system in response to a determination that said portable computer system is within a particular proximity to said plurality of server systems.”

With continued reference to the grounds for rejecting claim 45 (and similarly for claims 51 and 57), Appellants contend that the prior art as a whole, including the combination of *Klug*, *Gardenswartz*, and *Madison*, fails to disclose or suggest “generating a request to transmit a plurality of profile elements to a selected server system from among a plurality of server systems ... wherein said selected server system is identified at said portable computer system utilizing data within said plurality of profile elements specifying a consumer preference in response to a receipt of said request at said portable computer system.”

Page 4 of the final Office Action asserts that the combination of the prior art renders obvious “wherein said selected server system is identified at said portable computer system utilizing data within said plurality of profile elements specifying a consumer preference in response to a receipt of said request at said portable computer system.” The final Office Action fails to directly address the express limitation in claim 45 that the selected server system “identified at said portable computer system utilizing data within said plurality of profile elements specifying a consumer preference” is also the same server system selected from among a plurality of server systems to send the request to transmit multiple profile elements to. Appellants note that *Klug*’s description at col. 2, line 65 – col. 3, line 7 is limited to a very general description of possible multiple registrations in which a user requests automatic registration simultaneously. Nothing in *Klug*, *Gardenswartz*, and *Madison*, individually or in any combination, disclose or suggest a registration process including a step of transmitting a request to a portable computer system to transmit multiple profile elements to a selected server system from a plurality of server systems wherein the selected server system is “identified at said

portable computer system utilizing data within said plurality of profile elements specifying a consumer preference” as recited in claim 45.

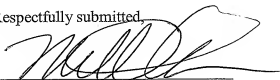
B. The rejection of claims 46-49, 52-55, and 58-59 under 35 U.S.C. §103(a) as being unpatentable over *Klug* in view of *Gardenswartz* and in further view of *Madison* is not well founded and should be reversed

Appellants do not concede that the combination of *Klug*, *Gardenswartz*, and *Madison* actually teaches or suggests any of the features of these dependent claims; however, these claims are directly or indirectly dependent on the independent claims 45, 51, and 57 which, as contended above by Appellants, have been incorrectly rejected under the references. By extension, the rejections of claims 46-49, 52-55, and 58-59 are not well founded and should be reversed.

CONCLUSION

Appellants have pointed out with specificity the manifest error in the Examiner's rejections, and the claim language that renders the invention patentable over the combination of references. Appellants, therefore, respectfully requests that this case be remanded to the Examiner with instructions withdraw the present claim rejections.

Respectfully submitted,



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CLAIMS APPENDIX

1-44. (Canceled)

45. A method for automatically electronically registering a user, said method comprising:
generating a request to transmit a plurality of profile elements to a selected server system
from among a plurality of server systems;
transmitting said request to a portable computer system in response to a determination
that said portable computer system is within a particular proximity to said
plurality of server systems;
receiving a user profile comprising said plurality of profile elements in a particular
transmittable data format at said selected server system from said portable
computer system, wherein
said selected server system is identified at said portable computer system utilizing
data within said plurality of profile elements specifying a consumer
preference in response to a receipt of said request at said portable
computer system,
said user profile is associated with a particular user of said portable computer
system, and
each of said plurality of server systems is respectively associated with one of a
plurality of consumer providers; and
registering said particular user with a consumer provider of said plurality of consume
providers in response to a receipt of said user profile at said selected server
system, wherein said consumer provider is associated with said selected server
system.
46. The method for automatically electronically registering a user according to claim 45,
wherein said registering comprises:
inserting each of said plurality of profile elements respectively into a specified plurality
of electronic registration elements required for electronic registration at said
selected server system; and

transmitting a registration indicator for said particular user from said selected server system to said portable computer system in said particular transmittable data format.

47. The method for automatically electronically registering a user according to claim 46, said method further comprising:

in response to a receipt of said registration indicator at said selected server system,
retrieving an electronic registration for said particular user.

48. The method for automatically electronically registering a user according to claim 45, said method further comprising:

automatically filtering a plurality of products and services offered by said consumer provider according to said user profile for said particular user; and
transmitting a specified offering from among said plurality of products and services to said portable computer system for said particular user.

49. The method for automatically electronically registering a user according to claim 45, wherein said particular transmittable data format comprises an extensible mark-up language data format.

50. (Canceled)

51. A system for automatically electronically registering a user, said system comprising:
means for generating a request to transmit a plurality of profile elements to a selected server system from among a plurality of server systems;

means for transmitting said request to a portable computer system in response to a determination that said portable computer system is within a particular proximity to said plurality of server systems;

means for receiving a user profile comprising said plurality of profile elements in a particular transmittable data format at said selected server system from said portable computer system, wherein
said selected server system is identified at said portable computer system utilizing data within said plurality of profile elements specifying a consumer

preference in response to a receipt of said request at said portable computer system,
said user profile is associated with a particular user of said portable computer system, and
each of said plurality of server systems is respectively associated with one of a plurality of consumer providers; and
means for registering said particular user with a consumer provider of said plurality of consume providers in response to a receipt of said user profile at said selected server system, wherein said consumer provider is associated with said selected server system.

52. The system for automatically electronically registering a user according to claim 51, wherein said means for registering comprises:

means for inserting each of said plurality of profile elements respectively into a specified plurality of electronic registration elements required for electronic registration at said selected server system; and
means for transmitting a registration indicator for said particular user from said selected server system to said portable computer system in said particular transmittable data format.

53. The system for automatically electronically registering a user according to claim 52, said system further comprising:

means for retrieving an electronic registration for said particular user, in response to a receipt of said registration indicator at said particular server system.

54. The system for automatically electronically registering a user according to claim 51, said system further comprising:

means for automatically filtering a plurality of products and services offered by said consumer provider according to said user profile for said particular user; and
means for transmitting a specified offering from among said plurality of products and services to said portable computer system for said particular user.

55. The system for automatically electronically registering a user according to claim 51, wherein said particular transmittable data comprises an extensible mark-up language data format.

56. (Canceled)

57. A computer program product residing on a computer usable medium and having computer readable program code means encoded therein for automatically electronically registering a user, said computer program product comprising:

program code means for generating a request to transmit a plurality of profile elements to a selected server system from among a plurality of server systems;

program code means for transmitting said request to a portable computer system in response to a determination that said portable computer system is within a particular proximity to said plurality of server systems;

program code means for receiving a user profile comprising said plurality of profile elements in a particular transmittable data format at said selected server system from said portable computer system, wherein

said selected server system is identified at said portable computer system utilizing data within said plurality of profile elements specifying a consumer preference in response to a receipt of said request at said portable computer system,

said user profile is associated with a particular user of said portable computer system, and

each of said plurality of server systems is respectively associated with one of a plurality of consumer providers; and

program code means for registering said particular user with a consumer provider of said plurality of consume providers in response to a receipt of said user profile at said selected server system, wherein said consumer provider is associated with said selected server system.

58. The computer program product according to claim 57, wherein said program code means for registering comprises:

program code means for inserting each of said plurality of profile elements respectively into a specified plurality of electronic registration elements required for electronic registration at said selected server system; and

program code means for transmitting a registration indicator for said particular user from said selected server system to said portable computer system in said particular transmittable data format.

59. The computer program product according to claim 58, said computer program product further comprising:

program code means for retrieving an electronic registration for said particular user, in response to a receipt of said registration indicator at said particular server system.

60-72. (Canceled)

EVIDENCE APPENDIX

Other than the Office Action(s) and reply(ies) already of record, no additional evidence has been entered by Appellants or the Examiner in the above-identified application which is relevant to this appeal.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings as described by 37 C.F.R. §41.37(c)(1)(x) known to Appellants, Appellants' legal representative, or assignee.